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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,648	01/10/2001	Larry Lunetta	2047.001US1	9518

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

PATEL, KANJIBHAI B

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/758,648	Applicant(s) LUNETTA ET AL.	
	Examiner Kanji Patel	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, 62, 63, 71-73, 75 and 80-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 16, 19-25, 32, 34-38, 42-46, 50-52, 55, 57-59, 62, 71-73, 75 and 80-105 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 33, 56 and 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/11/06, 12/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/06 and 12/21/06 have been entered.

Information Disclosure Statement

2. Information Disclosure statement submitted on 9/11/06 and 12/21/06 have been considered by the examiner.

3. The indicated allowability of claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, 62-63, 71-73, 75 and 80-105 is withdrawn in view of a new ground of rejection as set below.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 1, 5, 21-22, 25, 32, 34-38, 42-46, 50-52, 55, 57-59, 62, 71-73, 75, 80-105** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-3** of U.S. Patent No. **7,050,654 B2** in view of U.S. Patent No. **6,144,388** (IDS). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention, as defined in the instant claims, would have been obvious to one of ordinary skill in the art in view of the invention defined by claims 1-3 of the Lunetta et al. Patent No. 7,050,654 B2 in view of Bornstein Patent No. 6,144,388.

Specifically, claim 1 of Lunetta et al. Patent No. 7,050,654 B2 discloses all the limitations of instant claim 1 except the first image being generated from a product image file including **warp** information. However in the same field of endeavor (i.e. an image composition over a network), Bornstein discloses a computer-implemented process of generating a two dimensional image of a selected article of clothing superimposed at a location on a two-dimensional image of a person using a computer network having at least a server and a client computer, comprising the automatic generation of the composite image using the **warp information** included in the product image file (column 4, lines 15-33; column 14, lines 31-52; column 16, lines 22-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 2624

invention to use warp information in the product image file in the invention defined by claim 1 of Lunetta et al. as taught by Bornstein. Because such a modification will provide a system and method for quickly and precisely generating a two-dimensional image of a article of clothing superimposed on an image of a person that depicts the person normally and naturally wearing the article of clothing i.e. a photo realistic result, when in fact that person is not actually wearing that article of clothing as shown by Bornstein at column 2, lines 39-45. While the Lunetta et al. Patent includes various additional limitations not set forth in the instant claims, the use of the transitional term "including" in each of the instant claims fails to preclude to possibility of additional features. Therefore, the Lunetta et al. Patent claim 1 in view of Bornstein Patent sets forth each of the limitations of the instant claim 1 and is not patentably distinct therefrom.

Similarly instant independent claims 21, 34 and 42 would have been obvious to one of ordinary skill in the art in view of the invention defined by claims 2-3 of the Lunetta et al. Patent No. 7,050,654 B2 in view of Bornstein Patent No. 6,144,388.

Instant claim 50 and 57 are corresponding apparatus claims to process the method of instant claims. Therefore, these claims are also not patentably distinct. Similarly Lunetta Patent claims 1-3 in view of Bornstein Patent variously incorporate all the limitations of the instant dependent claims 5, 22, 25, 32, 35-38, 43-46, 51-52, 55, 58-59, 62, 71-73, 75 and 80-105 and therefore these claims are also not patentably distinct.

6. Claims 1, 21, 34, 42, 50, 57, 71-73, 75 and 80-105 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable

Art Unit: 2624

over claims 2-4 and 6-12 of copending Application No. 11/004,733, **which is now allowed**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on that copending applications since the referenced copending application and the instant application are claiming common subject matter, as follows:

Specifically, claim 2 of the copending application substantially includes each of the limitations of the instant claim 1. Similarly, copending applications claims 2, 6 and 9-12 set forth substantially identically each of the limitations of instant claims 1, 21, 34, 42, 50 and 57. While the copending application claim includes additional limitations or features, the instant claim includes the transitional term "including" which fails to preclude the possibility of additional elements. Therefore, the instant claims are not patentably distinct from the claims of the copending application. Furthermore, dependent claims 3-4 and 7-8 of the copending application variously incorporate all the limitations of the instant dependent claims 71-73, 75 and 80-105 and therefore these claims are also not patentably distinct from the claims of the copending application.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

7. **Claims 17-18, 33, 56, 63** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2624

The prior art on record fails to teach or fairly suggest that the photo sample is sent via network to a specified e-mail address as recited in claims 17, 33, 56 and 63. Furthermore, the prior art fails to teach or fairly suggest that a URL containing the photo sample is sent via network to a specified e-mail address as recited in claim 18.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kanji Patel whose telephone number is (571) 272-7454. The examiner can normally be reached on Monday to Thursday from 8 a.m. to 6:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lillis Eileen can be reached on (571) 272-6928 The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kanji Patel
Art Unit 2624
2/16/07


KANJIBHAI PATEL
PRIMARY EXAMINER